

REMARKS

Claims 1-27, 30-31, 33-36, 38 and 58 were previously canceled. Claim 52 has been withdrawn from consideration. Claims 37, 39 and 44 have been amended. Consistent with a telephonic discussion with the Office in January 2004, the inadvertent typeable error in claim 44 has been corrected. Claim 44 now recites “Triton® X-100” in lieu of “Tritox X-100”. Applicant submits herewith a reference that identifies Triton® X-100’s standard chemical make-up. Exhibit 1. Claims 28, 29, 32, 37, 39-57, and 59 are presently pending. No new matter has been added.

Favorable reconsideration and withdrawal are requested of the rejections of claims 37-39, 41-43, 45-47, 49, 51-53, 57 and 59 under 35 U.S.C. § 102(b) as being allegedly anticipated by Emerson *et al.*. The Office alleges that “the louse and tick taught by Emerson fall within the claimed classes *Dermanyssus* and *Varroa/Sarcopetes*, respectively.”

To anticipate a claimed invention under 35 U.S.C. § 102, the single prior art reference must teach each and every element of the claimed invention. Dayco Products, Inc. v. Total Containment, Inc., 66 U.S.P.Q.2d 1801, 1809 (Fed. Cir. 2003). Claim 37 has been amended to clarify that the claimed classes refer to mites, not louse or ticks. All of the other rejected claims depend from claim 37. Emerson does not teach the use of an ester to treat mites. Emerson treats ticks and louse with cinnamic aldehyde. Accordingly, Emerson does not teach each and every element of the claimed invention. Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b).

Claims 28, 29, and 32 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Emerson *et al.*.

To establish a *prima facie* case of obviousness, there must be 1) a suggestion to combine or modify, 2) a reasonable expectation of success and 3) the references must suggest all of the claim limitations. MPEP § 2143. Emerson does not render the claimed invention obvious. Mites, ticks, and louse are different organisms and thus, are classified separately. Exhibits 2, 3, and 4. For example, mites are microscopic organism, whereas ticks are visible to the naked eye. These different organisms often infect different hosts and cause different diseases. Exhibit 5. A treatment approach against ticks or louse does not necessarily apply effectively against mites. Emerson merely teaches that cinnamic aldehyde can be used to treat certain organisms. Nothing in Emerson suggests that an ester, such as *trans*-cinnamic acid ethyl ester, can be used to treat mites. A person of ordinary skill in the art would not have a reasonable expectation of success. Each organism

consists of a vast number of different species. For example, mites alone have over 30,000 species. It is unlikely that a cinnamic aldehyde compound would be active against all the species of mites. Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103.

Claims 40, 44, 48, 50 have been objected to as being dependent upon a rejected base claim. Claims 40, 44, 48, and 50 depend from claim 37. For the reasons discussed above, Applicant submits that claim 37 is patentable over Emerson, and is in condition for allowance. Thus, the objected claims should also be allowable. Withdrawal of the objection, therefore, is respectfully requested.

The Office alleges that claims 51 and 52 are duplicates and should be corrected. Claim 52 is hereby withdrawn. Applicant respectfully requests reconsideration and withdrawal of this objection.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant, therefore, respectfully requests that the Office reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Office believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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